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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,547	06/26/2001	Kazuhiko Sugawara	35.C15492	9436
5514	7590	12/17/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			NGUYEN, QUANG N	
			ART UNIT	PAPER NUMBER
			2141	

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/888,547	SUGAWARA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Quang N Nguyen	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 June 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-43 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 26 June 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 09/05/2004.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

***Detailed Action***

1. This Office Action is in response to the Application SN 09/888,547 filed on 06/26/2001. Claims 1-43 are presented for examination.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. **Claims 1-2, 7-13 and 18-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Iwazaki (US 6,687,742).**

4. As to claim 1, Iwazaki teaches a communication control method for electronic email system, comprising:

email transmitting means for sending email data accompanied by an image file (*Internet facsimiles 3 and 8 have both means functioning in transmission/reception emails with attached image*) (Iwazaki, C4:L56 – C5:L4);

requesting means for requesting reply email responsive to email to be sent when the email data is sent by said email transmitting means (Iwazaki, C6: L39-48);

communication managing means for managing transmission information for each of said sent email data (*the processing result from the response message is recorded in transmission history information*); and

control means for updating the transmission information which is managed by said communication managing means on the basis of a reception result of the reply email responsive to said sent email (*the processing result from the response message is recorded in transmission history information and if the receiver's capability is described in the response message, the sender checks the user defined filed and records the capability together with the email address of the receiver in the address book or the like of the sender*) (Iwazaki, C7:L51 – C8:L12).

5. As to claim 2, Iwazaki teaches the apparatus of claim 1, wherein said requesting means requests reply email indicative of a message disposition notification "MDN" of the email to be sent (Iwazaki, C6: L39-48).

6. As to claim 7, Iwazaki teaches a communication control method for electronic email system, comprising:

email receiving means for receiving email data accompanied by an image file (*Internet facsimiles 3 and 8 have both means functioning in transmission/reception emails with attached image*) (Iwazaki, C4:L56 – C5:L4);

detecting means for detecting control information which requests reply email from the email data received by said email receiving means (*the email analyzing section 26 checks the user defined field in the header of the received email message for control information requesting reply email*) (Iwazaki, C7: L28-43); and

notifying means for notifying the detection of said control information by visualizing means or monitoring means (*notifying the detection of said control information by the email analyzing section 26 monitoring the user defined field of the received email*) (Iwazaki, C7: L28-43).

7. As to claim 8, Iwazaki teaches the apparatus of claim 7, wherein said notifying means performs the notification before contents of the email whose control information was detected are visually outputted (*when the receiver recognizes the identification information, the email generator 25 generates an MDN message and returns the MDN message to the sender*) (Iwazaki, C7: L37-43 and C9: L51-56).

8. As to claim 9, Iwazaki teaches the apparatus of claim 7, further comprising output means for visually outputting contents of the image file attached to the received email

(each of the Internet facsimiles 3 and 8 comprises means for processing the image attached to the email) (Iwazaki, C10: L46-61), and wherein the image file attached to the email whose control information was detected is visually outputted, said notifying means adds information indicative of the detection of said control information to a part of said image (*information indicating the control method of the receiver and a capability response as information identifying the type of that email is added to the MDN message*) (Iwazaki, C9: L51-61).

9. As to claim 10, Iwazaki teaches the apparatus of claim 9, wherein when the image file attached to the email whose control information was detected is visually outputted, if the reply email responsive to said control information has already been sent, said notifying means adds information indicative of a completion of a response to said control information to a part of said image (“*capability response*” is added to the MDN message) (Iwazaki, C8: L1-25).

10. As to claim 11, Iwazaki teaches the apparatus of claim 7, wherein said requesting means requests reply email indicative of a message disposition notification “MDN” of the email (Iwazaki, C6: L39-48).

11. Claims 12-13 are corresponding method claims of apparatus claims 1-2; therefore, they are rejected under the same rationale.

12. Claims 18-22 are corresponding method claims of apparatus claims 7-11; therefore, they are rejected under the same rationale.

13. Claims 23 and 25 are corresponding computer program and computer-readable memory medium claims of apparatus claim 1; therefore, they are rejected under the same rationale.

14. Claims 24 and 26 are corresponding computer program and computer-readable memory medium claims of apparatus claim 7; therefore, they are rejected under the same rationale.

15. **Claims 27-28, 32 and 34-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Ohta (US 6,396,848).**

16. As to claim 27, Ohta teaches an image communicating apparatus for sending and receiving image information through a public line network, comprising:

*email means for sending and receiving email via an email server (network facsimile apparatus 2 sending and receiving email via POP server 3) enclosed in a communication network (Ohta, Fig. 1, C5:L61 – C6:L5);*

*memory means for storing communication management information of said email (a hard drive unit 25 for storing communications information and image information through various communication operations) (Ohta, Fig. 2, C6: L27-32 and C7: L11-25);*

communication management information forming means for, each time said email is sent by said email means, forming communication management information of said sent email and storing it into said memory means (*network facsimile apparatus 2 performs various communications operations to extract image/communications information for storing in the hard drive unit 25*) (Ohta, Fig. 6 and C11:L47 – C12:L65);

updating means for, when a delivery status notification for said sent email from said email server is received by said email means, updating contents of the communication management information of said email which received said delivery status notification in accordance with said received delivery status information (*marking an “OK” for a normal completion or a “NG” for an abnormal completion*) (Ohta, C14: L20-22); and

communication management report output means for outputting a communication management report indicative of the communication management information stored in said memory means (*outputting the communications history report 42 as illustrated in Fig. 9*) (Ohta, C14:L46-52).

17. As to claim 28, Ohta teaches the apparatus of claim 27, wherein said communication management information includes a transmission result of said sent email, and said updating means updates the transmission result of the communication management information of the email which received said delivery status notification in accordance with said received delivery status information (*marking an “OK” for a normal completion or a “NG” for an abnormal completion*) (Ohta, C14: L20-22).

18. Claims 32 and 34-35 are corresponding apparatus claims of apparatus claims 27-28; therefore, they are rejected under the same rationale.

19. Claims 36, 39 and 41-42 are corresponding image communicating apparatus, method, computer program and computer-readable memory claims of apparatus claim 27; therefore, they are rejected under the same rationale.

20. As to claim 37, Ohta teaches the apparatus of claim 36, wherein each of said communicating functions is a communication function according to each of the ITU-T recommendation T.30, T.37, and T.38 (Ohta, C10: L25-38).

21. Claim 38, 40 and 43 are corresponding method, computer program and computer-readable memory claims of apparatus claim 27; therefore, they are rejected under the same rationale.

***Claim Rejections - 35 USC § 103***

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**23. Claims 3-6 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwazaki, in view of Miyamoto et al. (US 6,327,046), herein after referred as Miyamoto.**

24. As to claim 3, Iwazaki teaches the apparatus of claim 1, but does not explicitly teach selecting means for selecting ON/OFF of an execution of said requesting means, and wherein said communication managing means manages ON/OFF of the request of said reply email as transmission information every sent email.

In a related art, Miyamoto teaches an electronic mail processing apparatus and method comprising a selecting device for selecting whether a request for reply to an electronic mail to be transmitted is to be made or not by marking the check box 19 in Fig. 5 to turn ON a reply email request (Miyamoto, C7: L41-44).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Iwazaki and Miyamoto to include a selecting means for selecting ON/OFF of the request of reply email as transmission information every sent mail since such methods were conventionally employed in the art to allow the sender to select whether a request for reply to an email from the receiver to be made or not at the time of transmitting the email; to specify a due date of reply and to retransmit the same email automatically when no reply has been received within a predetermined period of time.

25. As to claim 4, Iwazaki-Miyamoto teaches the apparatus of claim 1, wherein said control means updates the transmission information which is managed by said communication managing means to first information showing that the reply email responsive to said sent email has been received (Miyamoto, Fig. 8 and C7: L6-18).

26. As to claim 5, Iwazaki-Miyamoto teaches the apparatus of claim 1, wherein said control means updates the transmission information which is managed by said communication managing means to second information showing that the reply email responsive to said sent email is not received within a predetermined period of time (Miyamoto, Fig. 7 and C7: L6-18).

27. As to claim 6, Iwazaki-Miyamoto teaches the apparatus of claim 1, further comprising output means for visually outputting the transmission information, which is managed by said communication managing means (Miyamoto, Figs. 7-8 and C7: L6-18).

28. Claims 14-17 are corresponding method claims of apparatus claims 3-6; therefore, they are rejected under the same rationale.

**29. Claims 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohta, in view of Wing (US 6,650,440).**

30. As to claim 29, Ohta teaches the apparatus of claim 28, but does not explicitly teach wherein said delivery status notification for said sent email from said email server is a notification showing one of a “failed” notification, “delayed”, “normal end of transmission”, and “relayed” as a transmission result of said sent email.

In a related art, Wing teaches a communication system for transmission of facsimile information using an email message from a sending fax device to a receiving fax device through mailer devices including a sending gateway device and a receiving gateway device, wherein a DSN (Delivery Status Notification) confirmation request message can generate four types of responses: “Relay DSN”, “Delivery Success”, “Delivery Failure”, and “Delayed Delivery” (Wing, C9: L31-37).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Ohta and Wing to include delivery status notification showing one of a “failed” notification, “delayed”, “normal end of transmission”, and “relayed” as a transmission result of said sent email since such methods were conventionally employed in the art to allow the system to inform the sending user of the status of the delivery of the fax message.

31. As to claims 30-31, Ohta-Wing teaches the apparatus of claim 28, further comprising discriminating means for discriminating whether the delivery status notification for said sent email from said email server has been received by said email means after the elapse of a predetermined period of time from the transmission of said email or not (Wing, C9:L38 - C10:L28), and updating means updates the transmission

result in accordance with said received delivery status notification, and output means outputs a communication management report in which said transmission result was updated as a communication management report of said sent email (*outputting an “OK” for a normal completion or a “NG” for an abnormal completion to the communications history report 42 as illustrated in Fig. 9*) (Ohta, C14:L46-52).

**32. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohta, in view of Matsueda et al. (US 6,301,016), herein after referred as Matsueda.**

33. As to claim 33, Ohta teaches the apparatus of claim 32, but does not explicitly teach said error notification information output means comprises means for generating a warning sound as said error notification information.

In a related art, Matsueda teaches a data processing apparatus, such as a facsimile apparatus that transmits and/or receives data to and from another apparatus, comprising a loud speaker for generating a sound warning of the occurrence of an error or failure (Matsueda, C18: L23-25).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Ohta and Matsueda to include means for generating a warning sound as said error notification information since such methods were conventionally employed in the art to warn the user about the error, to give the user the information of the error occurrence, thereby allowing the user to take proper action for the error (Matsueda, C19: L8-29).

34. Further references of interest are cited on Form PTO-892, which is an attachment to this office action.

35. A shortened statutory period for reply to this action is set to expire THREE (3) months from the mailing date of this communication. See 37 CFR 1.134.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang N. Nguyen whose telephone number is (571) 272-3886.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's SPE, Rupal Dharia, can be reached at (571) 272-3880. The fax phone number for the organization is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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